

REMARKS

Claims 1, 3-6, 9-23, 27-29, 33-42, and 44-50 are before the Examiner. Claims 2, 7, 8, 25, 26, 30-32, and 43 have been cancelled without prejudice and Claims 44-50 have been added to more fully claim the invention disclosed in the application as originally filed. No additional claims fees are believed necessary in connection with this amendment, but the Office may charge any additional fees necessitated by this amendment to Deposit Account No. 50-0665.

Claim 1 has been amended to include the aspects of cancelled claims 2, 7 and 8; other aspects, as supported throughout the description, for example, at page 5, lines 7-9; at page 7, lines 31-32, to page 8, lines 1-3; and page 8, lines 26-32, of the description; and to broaden an aspect of the claim. Claim 18 has been amended to include the aspects of cancelled claims 2, 7, 8, 31, 32; other aspects, as supported throughout the description, for example, at page 5, lines 7-9; at page 6, lines 30-32, to page 7, lines 1-2; page 7, lines 31-32, to page 8, lines 1-8; and page 8, lines 26-32, to page 9, lines 1-8 of the description; and to broaden other aspects of the claim.

The non-narrowing amendments to claims 3, 4, 9, 11-15, 17, 27, 28, 33-35, 38-39, 41-42 include the correction of a typographical error and to provide proper claim dependencies and antecedents.

The Examiner's remarks in the Office Action with respect to claims 1-23 and 25-43 are addressed below.

35 U.S.C. 112

The Examiner has rejected claims 18-23 and 25-43 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserts that there is no support in the description for the phrase "for removing a portion of recyclable products from the municipal solid waste". Applicant respectfully disagrees with the Examiner, however, the amendments made to independent claim 18 has rendered this rejection moot.

35 U.S.C. 103(a)

The Examiner has rejected claims 1-8, 10-23, 25-32 and 34-43 under 35 U.S.C. 103(a) as being unpatentable over Howard *et al.* (British Patent No. 1,286,532) in view of Schultz (U.S. Patent No. 5,431,702) and Benson *et al.* (U.S. Patent No. 5,429,645).

As noted in the previous Office Action dated October 28, 2003, the Examiner asserted that Howard teaches combustible pellets and method for producing combustible pellets (see page 1, lines 21-39 and 57-81 and claims 1 and 2), wherein coal is further added to the fuel composition and the pellets have a 11,000 BTU per pound heating value. The Examiner asserted, however, that "Howard is silent to the teaching of the less than 10% by weight water content, fuel value of 12,000 to 14,000 BTU per pound, the dimension of the pellet, and an anaerobic digestion step following the separation and recyclable steps".

The Examiner also asserted that Benson teaches pellets and a method for producing the pellet comprising an anaerobic digestion step, column 4, lines 12-48 to produce high energy residue having a heat value at 8500 to 10,500 BTU per pound, abstract, column 8, lines 35-41, Fig. 7 and claims 1 to 10 and BTU values from 9,500-18,000, note Fig. 5, column 3, lines 12-17.

The Examiner further asserted that Schultz teaches briquettes of cylinder shape, column 5, line 36, having a dimension of 2 x 0.25 x 2.25, column 5, lines 50-52, the pellet having a water content of about 10 weight %, Example 7, that render obvious the 1-7% wt. water of the instant claims, note also the pellet having 10-12% wt. water at column 3, lines 35-37 and claims 24 and 7.

The Examiner asserted and re-asserts that it would have been obvious to one skilled in the art to use municipal solid waste having the moisture content, BTU values, and derived with the use of an anaerobic digestion step to produce pellets of the shape and dimensions of Benson and Schultz to render obvious the instant claims.

It is respectfully submitted that claims 1, 3-6, 9-23, 27-29, 33-42, and 44-50 submitted herewith are patentable over the cited references for the reasons set out

more fully below. The Examiner is respectfully reminded that the cited reference or combination of cited references must teach or suggest all the limitations of the claims; see *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970), wherein “all words in a claim must be considered in judging the patentability of that claim against the prior art”.

The claimed invention is directed to a pellet and a process for forming the pellet, wherein the pellet comprises recyclable-free, hazardous waste-free municipal solid waste, which is substantially free of glass, metals, plastics, and paper. As taught, for example, at page 8, lines 26-32 of the present application, municipal solid waste free of or having a low content of recyclable materials results in a cleaner burning fuel. For example, plastics containing traces of toxic metals used as catalysts, stabilizers or other additives; see page 7, lines 6-8, will contribute to unacceptable emission levels of the burning fuel of the cited art. In addition, incineration of waste comprising recyclables will result in a by-product of slag or ash, mainly consisting of glass and plastics, in the form of a solid clinker in the base of the furnace. Periodic shut-downs of incinerators are required for removal of such clinkers.

Howard is directed to removing metals and fines from raw refuse and other waste and mixing the resultant waste with coal and a bonding agent before pelletizing the resultant mixture. Howard does not teach or suggest using a recyclable-free, hazardous waste-free municipal solid waste in a pellet, wherein the municipal solid waste is substantially free of glass, metals, plastics, and paper, as claimed in the present invention, which results in a cleaner burning fuel. Furthermore, Howard does not teach or suggest a pellet or the making of a pellet, wherein the pellet has a fuel value of at least 10,000 BTU per pound comprising recyclable-free, hazardous waste-free municipal solid waste and at least one waste substance having a fuel value of at least 10,000 BTU per pound.

Benson, as taught at column 3, lines 12-21, is directed to the processing of municipal solid waste “to remove and recycle inerts and enhance or increase the organic component to form a Refuse Derived Fuel (RDF)” (emphasis added) to increase

the heating value of the RDF. The organic components are listed as paper, plastics etc.; see column 3, lines 14-16. Not only does Benson fail to teach or suggest the use of a recyclable-free, hazardous waste-free municipal solid waste in a pellet, wherein the municipal solid waste is substantially free of glass, metals, plastics, and paper, as claimed in the present invention, but, in fact, Benson teaches away from using a recyclable-free, hazardous waste-free municipal solid waste, as Benson teaches enhancing or increasing the organic component of the municipal solid waste, which includes paper and plastic. Furthermore, Benson does not teach or suggest a pellet or the making of the pellet, wherein the pellet has a fuel value of at least 10,000 BTU per pound comprising recyclable-free, hazardous waste-free municipal solid waste and at least one waste substance having a fuel value of at least 10,000 BTU per pound.

Schultz, as taught at column 2, lines 52-59, is directed to a process wherein dirt, metal, glass, and other inorganic matter is separated from the combustible organic matter of the municipal solid waste. The combustible organic matter of the municipal solid waste is referred to as Refuse Derived Fuel (RDF). The RDF is subsequently combined with, for example, coal and sewage sludge to form a briquette. Schultz fails to teach or suggest the use of a recyclable-free, hazardous waste-free municipal solid waste in a pellet, wherein the municipal solid waste is substantially free of glass, metals, plastics, and paper, as claimed in the present invention, which results in a cleaner burning fuel. In fact, Schultz teaches away from using a recyclable-free, hazardous waste-free municipal solid waste, as Schultz teaches the removal only of dirt, metal, glass, and other inorganic matter from the municipal solid waste leaving combustible organic matter, which includes paper and plastic. Furthermore, Schultz does not teach or suggest a pellet or the making of a pellet, wherein the pellet has a fuel value of at least 10,000 BTU per pound comprising recyclable-free, hazardous waste-free municipal solid waste and at least one waste substance having a fuel value of at least 10,000 BTU per pound.

The cited references do not, either singly or in combination, teach or suggest the use of a recyclable-free, hazardous waste-free municipal solid waste in a combustible pellet, as claimed, wherein the municipal solid waste is substantially free of glass,

metals, plastics, and paper, which results in a cleaner burning fuel. Moreover, the cited references do not, either singly or in combination, teach or suggest a pellet or the making of a pellet having a fuel value of at least 10,000 BTU per pound comprising recyclable-free, hazardous waste-free municipal solid waste and at least one waste substance having a fuel value of at least 10,000 BTU per pound.

The Examiner has also rejected claims 9 and 33 under 35 U.S.C. 103(a) as being unpatentable over Howard *et al.* (British Patent No. 1,286,532) combined with Schultz (U.S. Patent No. 5,431,702) and Benson *et al.* (U.S. Patent No. 5,429,645) as applied to claims 1-8, 10-32 and 34-42 above, and further in view of Chieffalo *et al.* (U.S. Patent No. 5,779,164).

For the reasons provided above with respect to Howard, Benson and Schultz, the cited references do not teach or suggest the use of a recyclable-free, hazardous waste-free municipal solid waste in a combustible pellet, as claimed. Consequently, the combination of Chieffalo with the teachings of Howard, Benson and Schultz does not teach or suggest the claimed invention.

Based on these submissions, the Applicant respectfully requests withdrawal of the rejection of the present claims.

Conclusions

For the reasons given above, Applicant respectfully requests reconsideration of this application and timely allowance of the pending claims. Applicant submits that the pending claims are in condition for allowance.

Respectfully submitted,
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